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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/443,505	11/19/99	AUDOUSSET M	05725.0496-0

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EXAMINER	
LIOTT,C	
ART UNIT	**PAPER NUMBER**
1751	5

DATE MAILED: 07/17/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/443,505	Audousset
Examiner	**Group Art Unit**
Caroline D. Liott	1751

☐ Responsive to communication(s) filed on _____ .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-18 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-18 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Claims 13-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 is indefinite with regard to the term "use." A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Replacement of this term with the term "application" can overcome this rejection.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-9 and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim '584 in view of Akram.

Lim, U.S. Patent No. 5,980,584, teaches the compound 1-(5-amino-2-hydroxyphenyl) ethane-1,2-diol as a primary intermediate for the oxidative dyeing of hair, see col. 3, lines 50-65. This compound falls within the scope of those of formula (I) as claimed. Lim teaches that the primary intermediate may be used in combination with a coupler, including the claimed 2,6-bis(hydroxyethylamino)toluene, as well as 2,4-diaminophenoxyethanol, see col. 5, lines 53-55 and col. 6, lines 31-45. Lim also teaches that additional p-aminophenols as claimed may be added to the compositions, see col. 6, lines 5-10. Lim exemplifies various compositions which contain the claimed 1-(5-amino-2-hydroxyphenyl)ethane-1,2-diol in the claimed amounts in combination with

2,4-diaminophenoxyethanol in the claimed coupler amounts, which compositions are mixed with a hydrogen peroxide oxidant and are applied to hair as claimed, see Examples 3-4, 11-12, 19-20 and 25-30; col. 21, lines 1-30; Table 6, Example 3, and Table 7, Example 8. Lim does not exemplify a composition or process as claimed, particularly which contains or uses the claimed coupler, and does not specifically teach kits as claimed.

Akram, U.S. Patent No. 5,230,710, teaches 2,6-diaminotoluenes of formula (I) for use as couplers in combination with a developer for dyeing keratin fibers, wherein Akram's preferred couplers include the claimed 2,6-bis(hydroxyethylamino)toluene, see Abstract; col. 2, lines 48-50, and col. 3, lines 60-64. Akram teaches that the patentee's couplers are an improvement over conventionally used coloring agents because they produce stable, bright, intense colorings, and because they have improved resistance to various agents including perspiration, acid rain, detergents, sunlight and UV radiation, see Abstract and col. 2, lines 20-26.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed 2,6-bis(hydroxyethylamino)toluene for use as a coupler in combination with Lim's 1-(5-amino-2-hydroxyphenyl)ethane-1,2-diol developer, such as by substitution of 2,4-diaminophenoxyethanol in the patentee's examples, resulting in dyeing compositions and processes as claimed, because Lim teaches the claimed coupler as being suitable for use in the patentee's compositions, and teaches the equivalence between the exemplified 2,4-diaminophenoxyethanol and the claimed coupler. Furthermore, Akram teaches that the claimed 2,6-bis(hydroxyethylamino)toluene is preferred and results in various improved dyeing properties

such as intense colors and resistance to various agents, therefore motivating those skilled in the art to select the claimed coupler from among those taught by Lim for use in Lim's compositions and processes, absent a showing otherwise. Lim's teaching of separate dye- and oxidant-containing compositions, which are mixed just before application, suggests their containment in conventional multi-compartment kits as claimed.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim '438 in view of Akram.

Lim, U.S. Patent No. 6,074,438, teaches and exemplifies compositions for dyeing hair which contain the claimed oxidation base 2-chloro-4-aminophenol in the claimed amounts and a pyrazolone coupler, see Abstract and Table 1, Composition C. The exemplified composition is mixed with a hydrogen peroxide oxidant as is applied to hair as claimed, see col. 10, line 65-col. 11, line 2. Lim teaches that additional couplers may be added to the compositions in order to obtain certain color nuances and tints, including the claimed 2,6-bis(hydroxyethylamino)toluene, as well as direct dyes and additonal p-aminophenol oxidation bases as claimed, see col. 5, lines 1-11 and 32-37, and col. 6, line 24. Lim teaches that the compositions may be packaged in kits as claimed, see col. 10, lines 46-54. Lim does not exemplify a composition, process or kit as claimed, particularly which contains or uses the claimed coupler.

Akram is relied upon above as teaching that the claimed 2,6-bis(hydroxyethylamino) toluene has many improved properties when used as a coupler in hair dyeing compositions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a composition for dyeing hair which contains an oxidation base and coupler as claimed, as well as the claimed additional couplers and direct dyes, wherein each component is present in the claimed amounts, is packaged in kits as claimed, and is applied to hair in dyeing processes as claimed, because such compositions, processes and kits fall within the scope of those as taught by Lim. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed 2,6-bis(hydroxyethylamino)toluene for use as the additional coupler in Lim's compositions because Lim teaches the claimed coupler as being suitable for use in the patentee's compositions, and because Akram teaches that the claimed 2,6-bis(hydroxyethylamino)toluene is preferred and results in various improved dyeing properties such as intense colors and resistance to various agents. Therefore, based upon Akram's teachings, those skilled in the art would have been motivated to select the claimed coupler from among those taught by Lim for use in Lim's compositions, absent a showing otherwise.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 09/443,142. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application recite keratin fiber dyeing compositions which contain at least one oxidation base and the claimed 1,3-bis(β-hydroxyethyl) amino-2-methyl benzene coupler, wherein the oxidation bases and couplers may be present in the claimed amounts, see e.g. copending claim 1. The compositions may be used in keratin fiber dyeing processes as claimed, and may be packaged in multi-compartment kits as instantly claimed, see e.g. copending claims 26 and 31. The oxidation bases in the copending application may be p-aminophenol oxidation bases as claimed, see copending claims 11-12. The instantly claimed compositions, processes and kits are therefore obvious over the claims of the copending application, absent a showing otherwise.

Similarly, claims 1-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 09/443,506. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application recite keratin fiber dyeing compositions which contain at least one oxidation base and the claimed 1,3-bis(β-hydroxyethyl) amino-2-methyl benzene coupler, wherein the oxidation bases and couplers may be present in the claimed amounts, see e.g. copending claim 1. The compositions may be used in keratin fiber dyeing processes as claimed, and may be packaged in multi-compartment kits as

instantly claimed, see e.g. copending claims 27 and 32. The oxidation bases in the copending application may be p-aminophenol oxidation bases as claimed, see copending claims 11-12. The instantly claimed compositions, processes and kits are therefore obvious over the claims of the copending application, absent a showing otherwise.

These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

Examiner notes Comparative Examples 3-5 in the specification which show that compositions which contain the claimed coupler in combination with the oxidation bases 3-methyl-4-aminophenol or 4-amino-3-fluorophenol as claimed (Examples 4 and 5 respectively) have unexpectedly improved resistance to shampooing as compared to a composition which differs only in that it instead contains the oxidation base p-aminophenol (Example 3). Comparative Example 3 is representative of Akram's closest teachings to the claimed invention (U.S. Patent No. 5,230,701 or DE 4,132,615 or GB 2,260,135).

The comparative Examples in the specification are not deemed persuasive to overcome the above rejections because no composition representative of the Lim patents was compared. Showings of unexpected results must compare the closest prior art. See *Ex parte Beck*, 9 USPQ 2d 2000 (BPAI 1987); *In re Burkel*, 201 USPQ 67 (CCPA 1979), and *In re Merchant*, 197 USPQ 785 (CCPA 1976).

Applicant is reminded that if any evidence is to be presented in accordance with 37 CFR 1.131 or 1.132, such evidence should be presented before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caroline Liott whose telephone number is (703) 305-3703. The examiner can normally be reached on Mondays-Thursdays from 8:30am to 6:00pm, and on alternate Fridays.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached at (703)308-4708. All before final official faxes should be sent to (703) 305-7718. All after final official faxes should be sent to (703) 305-3599. All non-official faxes should be sent to (703) 305-6078.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0661.

C.D.L.
July 14, 2000

CAROLINE D. LIOTT
PRIMARY EXAMINER